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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/630,925

07/31/2003

Masahiro Hori

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12/10/2004

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON, VA 20190

EXAMINER

ASSAF, FAYEZ G

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,925

Applicant(s)

HORI ET AL.

Examiner

Fayez G. Assaf

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/30/2004</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group 1: claims 1-21 in the reply filed on 11/30/2004 is acknowledged.

Claim Objections

Claim 20, the phrase "the predetermined surface profile" lacks antecedent basis.

Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7, 16-18, 20 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Goto et al. (US 6,582,826 B1).

Regarding claims 1, 20 and 21, Goto discloses an optical device comprising: a solid composition layer having a predetermined surface

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profile on a surface thereof; and a multi-layered dielectric film coating the surface of the solid composition layer (line 58 to line 60 of Col. 3).

Regarding claims 2-4, Goto discloses the glass transition temperature of the solid composition layer being not lower than 200°C (line 47 to line 54 of Col. 3).

Regarding claims 5-7, Goto discloses the linear thermal expansion coefficient of the solid composition layer being not larger than 150 ppm/°C (line 5 to line 8 of Col. 3).

Regarding claims 16-18, Goto discloses the multi-layered dielectric film including at least two layers formed with, as an essential ingredient thereof, a material selected from SiO₂, TiO₂, Ta₂O₅, ZrO₂, Nb₂O₅ and MgF₂ (line 64 to line 65 of Col. 10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-15 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goto et al.

Regarding claims 8-15, Goto discloses the claimed invention except for the particular material composition forming the solid composition layer.

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However, such determination of appropriate optical material(s) can be achieved by routine experimentation which does not serve as basis for patentability.

It would have been obvious, at the time the invention was made, to a person having ordinary skill in the art to provide the composition/optical material in order to improve thermal stability. Additionally, it has been held to be within the ordinary skill of worker in the art to select a known material on the basis of its suitability for the intended use. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945).

Regarding claim 19, Goto discloses the claimed invention except for coating the solid composition with SiO₂ film having a thickness between 1nm to 200nm.

However, silicon dioxide is conventionally used as an outer layer in optical devices such as filters and gratings.

It would have been obvious, at the time the invention was made, to a person having ordinary skill in the art to coat the solid composition with silicon dioxide in order to provide mechanical protection to the filter.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fayez G. Assaf whose telephone number is (571) 272-2307. The examiner can normally be reached on 8-5 M-F.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FA

12/8/04


FAYEZ G. ASSAF
PRIMARY EXAMINER